

AMENDMENT AFTER NON-FINAL ACTION

Appln. No. 10/729,763

Docket No. 442005-00122

REMARKS

Claims 1-2, 4-8, 10-12, and 19-21 were pending in the application. Claims 1, 4-6, 19, and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,515,271 to Auciello et al. ("Auciello '271"). Claims 1, 5-8, 10, 12, and 19-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,933,336 to Tolf, Jr. ("Tolf '336"). Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tolf '336 in view of Auciello '271. Claim 11 is purported to stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tolf '336 in view of any of U.S. Patent Nos. 1,603,245; 2,488,816; 3,265,349; and 5,390,465. Claims 12 and 19 are cancelled without prejudice. Claims 24 and 25 are submitted for examination.

Rejection of claims under § 102(b) as being anticipated by Auciello '271

Claims 1, 4-6, 19, and 20 stand rejected as being anticipated by Auciello '271. With particular regard to claim 19, the Office alleges that Auciello '271 discloses "a radially outwardly extending flange 12 formed at the outer end of the body" in Fig. 3.

Claim 19 has been cancelled and claim 1 has been amended to recite the limitation "a flange circumscribing a portion of the periphery of said elongate tubular body at said open outer end and extending radially outwardly therefrom so as to facilitate grasping of the flange prior to removal from a concrete void." Claim 1 has further been amended to recite that "[the] web being configured to both rupture and permit said body to collapse inwardly in response to a grasping force applied to said flange and directed longitudinally away from said elongate tubular body." Support for these amendments may be found in page 8 lines 7-16 of the specification, as further developed at page 4 line 22 to page 5 line 1, page 9 lines 1-6, and FIGS. 3A and 3B of the specification. We respectfully argue that the cited flange 12 neither extends radially outwardly sufficiently so as to facilitate grasping of the flange prior to removal from a concrete void nor may be grasped so as to effect a removal from a concrete void. We further note that the cited

AMENDMENT AFTER NON-FINAL ACTION

Appln. No. 10/729,763

Docket No. 442005-00122

flange 12 is disclosed as "an annular rib 12 which is designed to engage in an annular channel [of a] bottom closure 6, as is most clearly shown in FIG. 6." Auciello '271 at col. 3 ll. 57-60.

Therefore it is clear that the cited flange 12 is an element of a second closed end of a device, and not an open end as argued by the Office in the present rejection.

In view of the prior restriction requirement, claim 10 has been amended to recite the limitation "a flange generally circumscribing the periphery of said elongate tubular body at said open outer end and projecting perpendicularly outwardly therefrom, said flange being in overlapping contact with said edge surface of said mass." Support for this amendment may also be found in page 8 lines 7-16 of the specification, as further developed at page 4 line 22 to page 5 line 1, page 9 lines 1-6, and FIGs. 3A and 3B of the specification.

Rejection of claims under § 102(b) as being anticipated by Tolf'336

Claims 1, 5-8, 10, 12, and 19-21 stand rejected as being anticipated by Tolf'336. With particular regard to claims 1 and 10, the Office alleges that Tolf'336 discloses "[a] groove configured to both rupture and permit said body to collapse inwardly in response to a force applied to said body at said open end flange thereof." With regard to claim 6, the Office offers no argument or evidence of an alleged disclosure that "said outer surface of said body is substantially smooth" in the face of a clear disclosure of ribs 23 formed on and protruding from the side wall 10 of the device. Tolf'336 at col. 3 ll. 3-17. With regard to claims 8, 10, and 21, the Office offers no argument or evidence of an alleged disclosure pertinent to the limitation that "said elongate tubular body extends substantially parallel to said upper surface [of a mass of concrete]" in the face of a clear disclosure that the Tolf device is emplaced vertically within a concrete form. Tolf'336 at col. 4 ll. 33-43.

Claims 1 and 10 have been amended to recite the limitations "such that a web of material substantially thinner than said wall is retained between said groove and the other of said inner and outer surfaces" and "such that a web of material substantially thinner than said wall bridges

AMENDMENT AFTER NON-FINAL ACTION

Appln. No. 10/729,763

Docket No. 442005-00122

said groove," respectively. Support for these amendments may be found in page 4 lines 16-21, page 7 lines 1-7, and FIGS. 2 and 2A of the specification. We respectfully argue that Tolf '336 lacks any description of a groove or web configured to rupture in response to a force applied to the flange of the device, and in fact must resist any rupture of the grooves due to a sizing feature that requires a main section 31 to be telescoped through a collar section 32 with the ribs 24 out of alignment with the grooves 26 to produce a binding or frictional fit that holds the two sections in assembled relation. Tolf '336 at col. 3 l. 58 to col. 4 l. 8. We further note that the grooves and ribs of Tolf '336 are aligned such that there is no web of material substantially thinner than the wall of the device – e.g., the dimensions disclosed at col. 4 ll. 57-64 produce a wall that is 0.080 inch thick and a "web" that is 0.070 inch thick.

Rejection of claims under § 103(a) as being unpatentable over Tolf '336 in view of Auciello '271

We respectfully submit that the rejection of claim 11 is moot in view of the amendments to claim 10 described above.

Rejection of claims under § 103(a) as being unpatentable over Tolf '336 in view of any of U.S. Patent Nos. 1,603,245; 2,488,816; 3,265,349; and 5,390,465

Claim 11 is purported to stand rejected over the above-identified combination. As best understood, this rejection is directed to the subject matter of claim 2. The Office alleges that "to have formed the radially outwardly extending flange 12 of the [Tolf '336] void former 10 with a slot, thus serving to more effectively fasten the void former 10 to a concrete form... or to save on material... or to allow for adjustment... would have been obvious to one having ordinary skill in the art."

We respectfully note that claim 2 required "a slot formed in said flange having side edges positioned on opposite sides of said groove [with the groove terminating at the flange]." The rejection is incomplete because it fails to account for the specific placement of the slot with respect to the groove. Distilling an invention down to the "gist" or "thrust" of an invention

AMENDMENT AFTER NON-FINAL ACTION

Appln. No. 10/729,763

Docket No. 442005-00122

disregards the requirement of analyzing the subject matter "as a whole." MPEP § 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983)). The Office's rejection does not cite to a structure or rationale that would lead one of ordinary skill to select the recited placement versus other placements, each of which would be at least equally desirable with regard to the cited rationales for incorporating a slot.

Claim 2 has been amended to specify that "said groove extends along said body and terminates within the slot." New claim 24 recites this same limitation. Support for these amendments may be found in page 8 lines 9-12 of the specification. We respectfully argue that the Office has not established a legally sufficient *prima facie* case of obviousness which addresses the specific limitations recited in the Applicant's claim, and that none of U.S. Patent Nos. 1,603,245; 2,488,816; 3,265,349; and 5,390,465 provide evidence of a structure or rationale pertinent to the recited limitation.

Other Amendments to the Claims

Claim 7 has been amended to recite "a mass of plastic concrete" and "[the] body being positioned in said mass with... said flange positioned in contact with said outer surface [of the mass]." Support for this amendment may be found in page 4 lines 2-5, page 9 lines 1-6, and FIGS. 3A and 3B of the specification.

New claim 25 recites the limitation "wherein said elongate tubular body is formed without a taper along a substantial majority of its length so as to form a substantially cylindrical void in said mass." Support for this amendment may be found in page 8 lines 3-6 of the specification.

AMENDMENT AFTER NON-FINAL ACTION

Appln. No. 10/729,763

Docket No. 442005-00122

Conclusion

In view of the foregoing remarks, we respectfully submit that the present claims are allowable over the art of record and pray for a prompt allowance. The Commissioner is authorized to charge any additional fees required by this filing, or to credit any overpayment of fees submitted with this filing, to Deposit Account No. 20-0809.

Respectfully submitted,

/David R. Jaglowski/

David R. Jaglowski

Reg. No. 58,514

THOMPSON HINE LLP

P.O. Box 8801

Dayton, Ohio 45401-8801

Telephone: (937) 443-6600

Facsimile: (937) 443-6635

E-mail: IPGroup@ThompsonHine.com

511145.1